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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/033,397	12/27/2001	Hiromi Yatsuda	5622DIV	9918

7590 11/20/2002

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EXAMINER

COTHORN, JUDITH A

ART UNIT	PAPER NUMBER
2822	

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/033,397	HIROMI YATSUDA
Examiner	Art Unit	
Judith A. Cothorn	2822	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 27 December 2001.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 13-20 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 13, 15, 17, 19 and 20 is/are rejected.

7) Claim(s) 14, 16 and 18 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 27 December 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. 09/583,382.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_

## **DETAILED ACTION**

This office action is in response to pre-Amendment A filed on 12/27/01.

### *Drawings*

Figures 12A, 12B, 20A, and 20B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

The disclosure is objected to because of the following informalities: The reference signs for Prior Art figures 12A and 12B are not disclosed in the specification and do not match with the reference signs that are disclosed on pages 2-3 of the specification. In addition, on page 11 of the specification, lines 16-17, it is disclosed that Fig. 20B is a sectional view of the conventional electronic component of Figure 12, taken along line A-A in figure 12A. However, Figure 12A does not have a line A-A, rather line I-I is in figure 12A.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 is confusing and/or indefinite, since it is unclear what the applicant is attempting to claim. In claim 19, are there two additional electrically conductive members formed? What does a first electrically conductive member "previously formed" mean? Does that mean prior to the first step? Furthermore, is the second electrically conductive member formed in addition to the electrically conductive member formed in the second step?

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-15, 17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morishima (US2001/0011857) in view of Kobayashi et al. (5,311,402).

Morishima discloses a method (Figures 6, 7 and 9A-9F) comprising the steps of: a first step in which one face of a plurality of sealing walls (7) are closely adhered (paragraph 53) to one main surface of said first substrate (1) which has a plurality of electronic circuit devices (1A) formed on said one main surface in a plurality of circuit regions and a plurality of electrode pads (10) in electrical connection with said plurality of electronic circuit devices (paragraph 31), said plurality of sealing walls (7) each configured to enclose each of said plurality of electronic circuit devices with each of said plurality of electrode pads arranged outside of each of said

plurality of sealing walls (paragraph 54; figure 7), and in which said second substrate (3) is closely adhered to the other faces of said plurality of sealing walls (paragraph 55); a second step in which an electrically conductive member (6) is formed on each of said plurality of electrode pads (10), said electrically conductive member being electrically connected with each of said plurality of electrode pads; and a third step in which said first substrate (1), together with said second substrate (3), is severed for each of said plurality of circuit regions, to obtain a plurality of electronic components (paragraphs 73 and 74).

Morishima fails to disclose the second substrate having a plurality of openings at sites where bonding occurs, in particular at sites that confront said plurality of electrode pads for bonding.

Kobayashi et al. (5,311,402) disclose a substrate having openings (Figure 5, 40) at sites where bonding occurs.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Morishima to have the second substrate with a plurality of openings as taught by Kobayashi et al. in order to adjust the amount of space between the second substrate and the first substrate.

#### *Allowable Subject Matter*

Claims 16 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additionally cited art disclose the formation of surface acoustic wave devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judith A. Cothorn whose telephone number is 703-305-4733. The examiner can normally be reached on Mon-Fri, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amir Zarabian can be reached on 703-308-4905. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

jac  
November 18, 2002

  
Mary Wilczewski  
Primary Examiner